



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,305	11/12/2003	Darko Kirovski	MS1-1659US	5766
22801 7590 07/20/2009 LEE & HAYES, PLLC 601 W. RIVERSIDE AVENUE SUITE 1400 SPOKANE, WA 99201				
EXAMINER JACKSON, JENISE E				
ART UNIT		PAPER NUMBER		
2439				
MAIL DATE		DELIVERY MODE		
07/20/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,305

Applicant(s)

KIROVSKI, DARKO

Examiner

JENISE E. JACKSON

Art Unit

2439

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 18-29, 36-45, 49-60 and 67-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 18-29, 36-45, 49-60, 67-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-11, 18-29, 36-45, 49-60 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

1. Applicant's election without traverse of Group I in the reply filed on 3/26/09 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4-6, 8-11, 18, 21-23, 25-29, 36, 39-45, 49, 52-54, 56-60, 67, 70-75, 78-86 rejected under 35 U.S.C. 102(e) as being anticipated by Levy(2003/0053656).
4. As per claims 1, 18, 49, 67, Levy discloses an optical data storage medium[0017], comprising: optically-readable material suitable for storing data therein(i.e. optical data storage medium can store images, video audio and/or data)[0017]; and stored within said optically-readable material, instructional data for an optical media content protection scheme(i.e. watermark)[0026], said instructional data being configured to cause logic associated with an optical media receiving device to operatively perform in accordance with said optical media content protection scheme when programmed using said instructional data and accessing associated content data stored on said optical data storage medium[0033, 0051].
5. As per claims 4, 21, 39, 52, 70, 78, Levy discloses at least one type of additional data stored within said optically-readable material, said type of additional data being selected from a

group of additional data comprising substantially unique identifier data associated with said optical data storage medium[0041].

6. As per claims 5, 22, 40, 53, 71, 79, Levy discloses at least one optically-detectable authentication feature (i.e. watermark)[0029, 0031].

7. As per claims 6, 23, 42, 54, 80, Levy discloses wherein said optically-detectable authentication feature includes a plurality of optically-detectable authentication features forming a substantially unique pattern(i.e. pit pattern) using at least one optically detectable material[0026, 0045].

8. As per claims 8, 25, 41, 43, 56, 81, Levy discloses wherein said plurality of optically-detectable authentication features form an optically-detectable certificate of authentication (COA)(i.e. resulting hash based on the visual pattern)[0041].

9. As per claims 9, 26, 44, 57, 72, Levy discloses COA information data stored within said optically-readable material[0041].

10. As per claims 10, 27-28, 45, 58-59, 73-74, 83, Levy discloses COA related signature data[0041].

11. As per claims 11, 29, 60, Levy discloses at least one top surface material and wherein at least one of the following occurs: said at least one optically-detectable authentication feature is formed on said top surface material[0034-0035].

12. As per claim 36, Levy discloses an apparatus comprising: a data storage device configurable to write data to an optical data storage medium[0017, 0033]; and logic operatively coupled to said configured to said data storage device and configured to cause said data storage device to record instructional data for an optical media content protection scheme within said

optical data storage medium, said instructional data being configured to cause logic associated with an optical media receiving device to operate in accordance with said optical media content protection scheme when programmed using said instructional data and accessing associated content on said an optical data storage medium[0026, 0031, 0055].

13. As per claim 75, Levy discloses an apparatus comprising: non-volatile memory; an interface mechanism suitable for receiving a removable optical data storage medium[0017, 0033], accessing instructional data associated with an optical media content protection scheme from said optical data storage medium, and outputting said accessed instructional data; logic operatively coupled to said interface mechanism and said non-volatile memory and configured to receive said accessed instructional data and in response thereto update a current optical media content protection scheme stored in said non-volatile memory and thereafter while accessing associated content data stored on said optical data storage medium operatively adhere to said updated current optical media content protection scheme[0026, 0033, 0051].

14. As per claim 82, Levy discloses wherein said interface mechanism is further configured to access COA information data stored within said optical data storage medium and provide said COA information data to said logic[0041].

15. As per claim 84, Levy discloses wherein said logic is further configured to verify said COA information data, and is configured to update said current optical media content protection scheme stored in said non-volatile memory once said COA information data has been verified [0033, 0041].

16. As per claim 85, Levy discloses wherein said interface mechanism is further configured to access license information data stored within said optical data storage medium and provide

said license information data to said logic, and wherein said logic is configured to verify said license information data to determine if content data stored on said optical data storage medium can be accessed [0032, 0044].

17. As per claim 86, Levy discloses wherein said logic maintains license usage information within said non-volatile memory [0032].

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 2-3, 19-20, 37-38, 50-51, 68-69, 76-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy(2003/0053656) in view of Fontijn et al(2005/0246777).

20. As per claims 2, 19, 37, 50, 68, 76, Levy is silent on wherein said optical media content protection scheme includes a digital rights management (DRM) protection scheme. Fontijn et al. discloses wherein said optical media content protection scheme includes a digital rights management (DRM) protection scheme [0003, 0045]. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a optical media content protection scheme includes a digital rights management(DRM) protection scheme of Fontijn with Levy, the motivation is that when the user data is read from the optical media the usage restrictions defined in the DRM will be read, and the usage rights will indicate if the user is allowed to make copies of the content, thus DRM is a copy protection scheme that protect unauthorized usage of software[0045 of Levy].

21. Same Motivation as above. As per claims 3, 20, 38, 51, 69, 77, Levy discloses wherein said includes at least one marking scheme includes a data-implemented water marking scheme[0026]. Levy is silent on a DRM protection scheme. Fontijn discloses a DRM protection scheme[0003, 0045].
22. Claims 7, 24, 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy(2003/0053656) in view of Yamasaki et al(20040141456).
23. As per claims 7, 24, 55, Levy is silent on wherein said optically detectable material includes at least one material selected from a group of optically detectable materials comprising an opaque material, a partially opaque material, a polymer-based material, and an epoxy-based material. Yamasaki discloses wherein said optically detectable material includes at least one material selected from a group of optically detectable materials comprising a polymer-based material[0023, 0033-0034]. It would have been obvious to one of ordinary skill in the art at the time of the invention to include polymer-based material of Yamasaki with Levy, the motivation is that optical recording medium includes as a light transmitting protective film above the optical recording layer a polymer sheet produced by melt casting and an adhesive layer for bonding the polymer sheet to the optical recording layer to enable recording[0030 of Yamasaki].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENISE E. JACKSON whose telephone number is (571)272-

3791. The examiner can normally be reached on Increased Flex time, but generally in the office M-Fri(8-4:30)..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on (571) 272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christian LaForgia/
Primary Examiner, Art Unit 2439

July 15, 2009
/J. E. J./
Examiner, Art Unit 2439